

REMARKS

35 USC § 103

The Office rejected all of the pending claims as being obvious over Johnson (6392592) in view of Hoffman (5742233). The applicant disagrees with those rejections because the Office failed to set forth a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. [M.P.E.P. §2142]

The January 24th Office Action fails to satisfy that burden. With respect to claim 26, there are at least three elements missing from Johnson -- both the first and second triggers, and the inclusion of both types of triggers in a single remote control unit for a car alarm. The Office says that those elements would be obvious to combine because they are conventional in the art. But that is not the point. The Office has the burden of identifying specific teachings, suggestions or motivations in the prior art for the claimed combination. Merely pointing out that various elements by themselves are known in the prior art is insufficient. Nor is it sufficient to merely state that combination of the missing elements is obvious because their combination would be beneficial. If that were the standard nothing would ever be patentable.

Pending claim 26 recite limitations of a single device (a remote control unit for a car alarm) that transmits a local signal to a car, and a distal signal to a distal location. Johnson does indeed teach a key fob that transmits a signal locally to a car, and Hoffman teaches a key chain that transmits a signal distally to a distant location. But Johnson fails to teach transmission of the distal signal, and Hoffman fails to teach transmission of a local signal. The Office has

completely failed in its burden of identifying specific teaching, suggestion or motivation in the prior art to combine those features within a single device.

The rejections of claims 27-32 are all moot in view of their dependency on allowable claim 26. It is logically impossible for a dependent claim to be validly rejected as obvious when the parent claim is allowable.

Request For Allowance

In view of the foregoing, it is respectfully submitted that all of the pending claims of the subject patent application are in a condition for immediate allowance. *Moreover, given the long prosecution history, the applicant requests a quick turnaround on the next office action. If the examiner continues to reject the claims, the applicant will file an immediate appeal.*

Respectfully submitted,
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